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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/728,302 | 12/01/2000 | James S. Tagg | 10003964-1 | 4920 |

7590 03/11/2004
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

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| EXAMINER |
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YUSSUF, SAJID

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| ART UNIT | PAPER NUMBER |
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2141

DATE MAILED: 03/11/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

2

Office Action Summary

Application No.

09/728,302

Applicant(s)

TAGG, JAMES S.

Examiner

Sajid A Yussuf

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. ***Claim(s) 1-7, 9-15, 17, 18 is/are rejected under 35 U.S.C. 102(e) as being anticipated by Potts et al. (US Patent No. 6,026,432 and Potts hereinafter)***

5. As per claim(s) 1, 9, 17 Potts discloses providing a website (i.e., Hyperlink) having a web page (i.e., HTML) accessible via a browser program, the browser program having browser print controls for initiating processing of print jobs, (See Column 3 Lines 50-67 & Column 4 Lines 1-4); providing printable content that is associated with the website but not displayed on the web page, (See Column 4 Lines 50-67); providing a print activator on the web page, where activation of the print activator enables a user to initiate printing without having to operate the browser print

controls, (See Column 5 Lines 1-25); and in response to user activation of the print activator, printing the printable content at a printer, (See Column 5 Lines 1-25).

6. As per claim(s) 2,10 Potts teaches the claimed invention as described in claim(s) 1 & 9 above and furthermore discloses the printable content is a catalog featuring consumer products and/or services; wherein any web site broadly specified in the reference could provide websites related to products and/or services that could be featured in the catalog, (See Column 5 Lines 40-67);

7. As per claim(s) 3,11 Potts teaches the claimed invention as described in claim(s) 1-2 & 9-10 above and furthermore discloses the print activator takes the form of a hyperlink that identifies the printable content, (See Column 4 Lines 30-67 & Figure 4).

8. As per claim(s) 4,12 Potts teaches the claimed invention as described in claim(s) 1-3 & 9-11 above and furthermore discloses the print button activates the print processing functions provided on the computer running the browser program, (See Column 4 Lines 35-49).

9. As per claim(s) 5,13 Potts teaches the claimed invention as described in claim(s) 1-4 & 9-12 above and furthermore discloses activation of the print button causes printing to be performed by bypassing the print features provided on the browser program, (See Column 4 Lines 62-67 & Column 5 Lines 1-25).

10. As per claim(s) 6,14 Potts teaches the claimed invention as described in claim(s) 1-6 & 9-13 above and furthermore discloses where the print button causes the printable content to be downloaded, (i.e., printed) directly to the printer, (See Column 5 Lines 1-34).

11. As per claim(s) 7,15 Potts teaches the claimed invention as described in claim(s) 1-7 & 9-14 above and furthermore discloses the printable content is separated into a plurality of sections (i.e.,

directory/sub-directory) that are downloaded individually (i.e., printed) to the printer, (See Column 6 Lines 9-31).

12. As per claim(s) 18 Potts discloses storing the catalog, (i.e., packets or presentations) in computer-readable form in a memory (i.e., servers) location accessible from a communications network; providing a website that is related to products and/or services; wherein any web site broadly specified in the reference could provide websites related to products and/or services featured in the catalog, (See Column 5 Lines 40-67); referencing (i.e., hyperlinks) but not displaying the catalog on the web page included on the website, (See Column 5 Lines 40-50), where a user-actuable print activator is displayed on the web page; and in response to customer activation of the print activator, initiating printing of the catalog (i.e., packets or presentations) at a local printer, where the printing is initiated without the customer having to operate print controls included on a browser program used to display the web page, (See Column 5 Lines 1-35).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Determining the scope and contents of the prior art.
Ascertaining the differences between the prior art and the claims at issue.
Resolving the level of ordinary skill in the pertinent art.
Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claims 8, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potts et al. (US Patent No. 6,026,432 and Potts hereinafter) in view of Goodwin et al. (US Patent Application Publication No. 2002/0099791 and Goodwin hereinafter).

16. As per claim(s) 8,16 Potts discloses the claimed invention as described above.

However, Potts does not explicitly teach the printable content is not formatted for display by the web browser, but rather is specially formatted for output in printed hard copy form.

Goodwin teaches the printable content is not formatted for display by the web browser, but rather is specially formatted for output in printed hard copy form, (See Column 3 Paragraph 0056).

Therefore it would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to modify the teaching of Potts with the teachings of Goodwin to include the printable content specially formatted for output in printed hard copy form with the motivation to provide for determining how much content of each web page is to be printed and how the determined content is to be printed on receipt paper, (See Goodwin Column 1 Paragraph 0009).

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Kelley et al. (US Patent No. 6,320,671) discloses web browser printing enhancements;

B. Potts (US Patent No. 6,314,432) discloses a system and method for retrieval, saving and printing of using hyperlinks; and

C. Robertson et al. (US Patent No. 6,507,410) discloses method for non-linear document conversion and printing;

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sajid A Yussuf whose telephone number is (703) 305-8752. The examiner can normally be reached on Monday-Thursday 7:30-5:00 PM and Alternate Fridays.

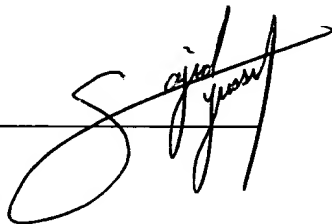
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Sajid Yussuf
Patent Examiner
Technology center 2100
5 March 2004



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PRIMARY EXAMINER